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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,573	04/10/2001	Ryuichiro Hisamatsu	450100-03152	7755

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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/829,573

Applicant(s)

HISAMATSU ET AL.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This Office action is in response to Applicant's amendment, filed on 01/13/2005.
2. Claims 1-22 are pending.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pargée, Jr. (U.S. Pat. No. 4,422,093), Stern (U.S. Pat. No. 6,591,247), and Brown (U.S. Pat. No. 6,611,842) in view of Leistensnider et al. (U.S. Pat. No. 6,839,685).

**As per claims 1, 3-6, 8, and 10-22, Pargée** substantially discloses a virtual service that employs the full facilities of a satellite television communication channel, comprising the steps of:

obtaining information about earnings and expenses based on expenses incurred by content providers (content providers or satellite television broadcasting, cable television) supplying users with recording devices compatible with contents offered by the providers (see., abstract, col 3, lines 15-30, col 6, lines 18-38). Pargée fails to explicitly

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disclose advertisements and fees included in the contents. However, Stern discloses an advertising and payment method/system to disseminate information concerning multiple products. The advertisements information is associated with various products or contents (see., abstract, col 1, lines 37-67, col 3, lines 12-32, col 4, lines 46-67, it is obvious to recognize that satellite or cable broadcastings provide earnings for service provide to consumers). Therefore, it would have bee obvious to a person of ordinary skill in the art at the time the invention was made to modify the television burst service of Pargee by including the limitations detailed above as taught by Stern because this would advertise consumers in the television industry while ensuring that consumers is ready to perceive the message content of the advertisement.

Pargee and Stern fail to explicitly disclose the Applicant's newly added limitation wherein said determining said services and/or advertisements to be provided to said users based on said users viewing history data. Brown discloses a computer system that includes a database storing user histories of selected products. A user profile data that can be utilized to provide targeted advertising and/or to automatically select products are identified with similar underlying characteristics of the user. A television recording apparatus that automatically records television programs based on a correspondence between program profile data associated with the television programs and user profile data that has been generated based on past history of the user's viewing habits (see., abstract, col 1, lines 16-26, col 3, lines 4-30). It would have bee obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Pargee and Stern by including the limitations detailed above as

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taught by Brown because this would provide data or advertisements which reflect individual preferences.

Pargee, Stern, Brown fail to disclose Applicant's newly added limitations wherein said judging whether or not it is possible to pay back a share of the earnings, and initiating a process to decide on items applicable to pay back when it is judged that pay back is possible.

Leistensnider discloses a computer-implemented method/system for selecting stock equities for inclusion in a strategic investment portfolio includes identifying stocks for dividends, earnings per share, earnings growth, market capitalization, as well as the earnings per share as of the previous 12, 14 and 36 months. At step 310, the earnings per share (EPS) for each year in the four year period is checked to determine whether it is positive or negative (see., abstract, col 2, lines 55-67, col 3, lines 30-47). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Pargee, Stern, and Brown by including the limitations detailed above as taught by Leistensnider because this would provide earnings per share in a business management environment.

**As per claims 2, and 9, Pargee** discloses the claimed method wherein said services constitute electronic commerce practiced by virtual shops (see., abstract, specifically wherein it is stated that a virtual service that employs the full facilities of a television communication channel on an intermittent basis, col 3, lines 3, lines 19-67).

**As per claim 7, Pargee** discloses the claim method wherein said recording devices each include a hard disc drive (fig 4, col 7, lines 17-50).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 13 and 19 are rejected under 35 U.S.C 101 because, the claimed invention is directed to a non-statutory subject matter, specifically, the claims are directed towards an abstract idea. Claims 1, 13 and 19 represent an abstract idea that does not provide a practical application in the technological arts. There is no computer performing any step or any mathematical calculation with no post solution activity. Therefore, applicant is advised to embed a computer or a processor or module into the claims in order to overcome the 101 rejection.

**RESPONSE TO ARGUMENTS**

6. Applicant's arguments filed on 01/13/2005 have been fully considered but they are moot in view of new ground (s) of rejection.

***Conclusion***

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

**Primary Patent Examiner**

**April 20, 2005**